

REMARKS

It should be strongly noted that the excerpts cited below are set forth for illustrative purposes for purpose of providing at least one exemplary embodiment of the cited claim language. The claim language should not be construed as being limited to such exemplary excerpts in any manner whatsoever.

The Examiner has rejected Claim 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner has argued the following:

Applicant has amended the independent claims to include the limitation of displaying statistics regarding a number of the patents of the set in each category of technology *in a first interface*, displaying first additional information associated with at least a portion of the patents of the set *in a second interface separate from the first interface* upon the selection of an icon *positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second,*

displaying second additional information associated with at least one of the patents of the list *in a third interface separate from the first interface and the second interface* upon the selection of an additional icon *positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface*

The Examiner request that the applicant direct the Examiner to where there is support for the newly added limitations.

In response, applicant draws the Examiner's attention to Figures 13, 15-16 and the quoted excerpt from page 29, lines 22-24; page 32, lines 8-25; and page 33, lines 6-14.

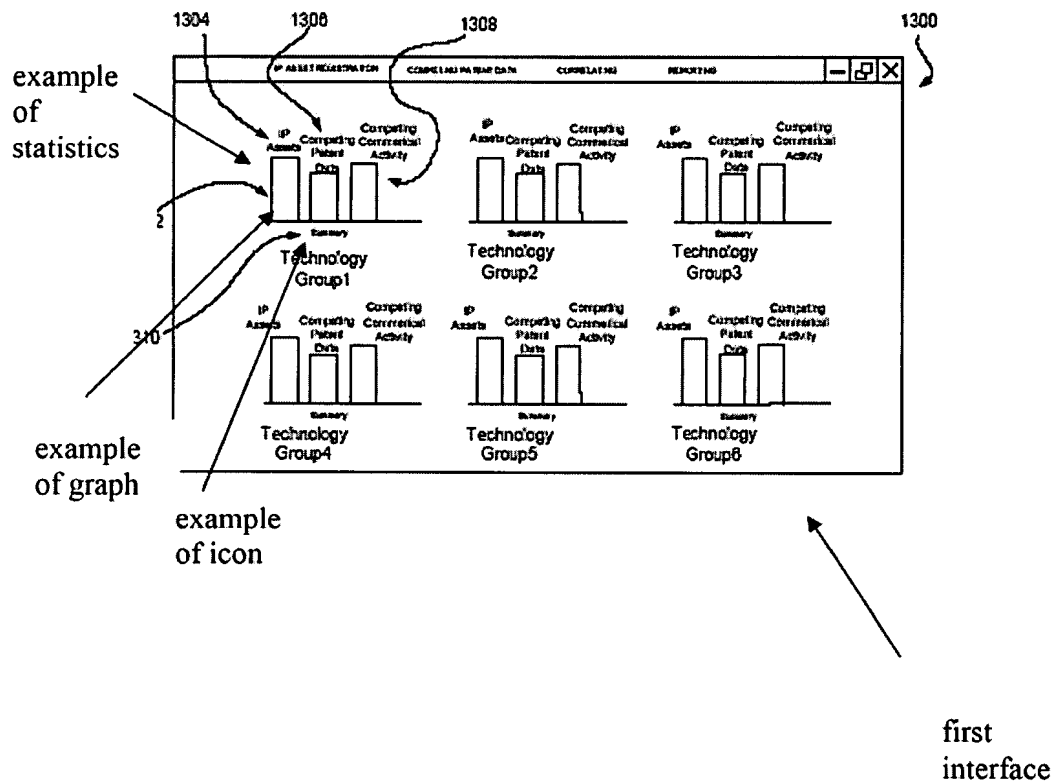


Figure 13

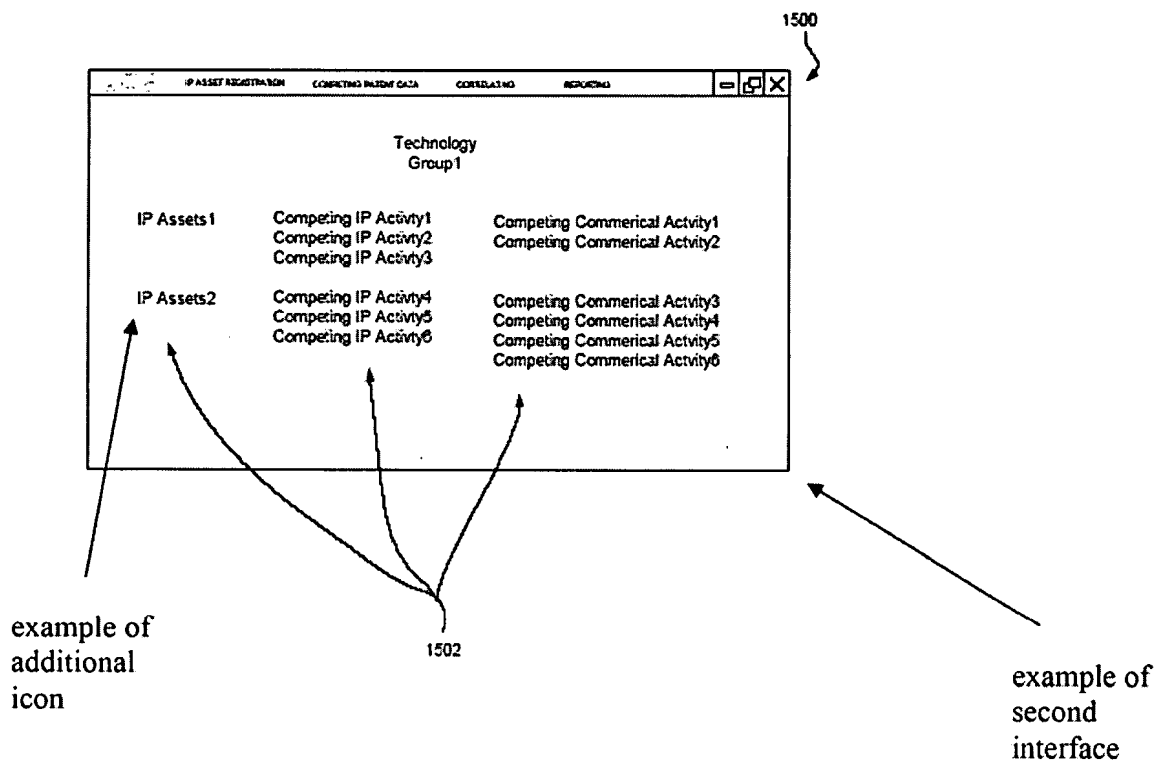


Figure 15

“Figure 15 illustrates an exemplary summary report 1500, in accordance with one embodiment. Such report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of Figure 13. In the alternative, such page may be generated in utilizing the report definition interface 1200 by selecting a particular technology category via pull-down window 1204, selecting all of the intellectual property identifiers via pull-down window 1202, and selecting a summary format type. Of course, the summary report 1500 may be generated in any desired manner.”
(emphasis added)

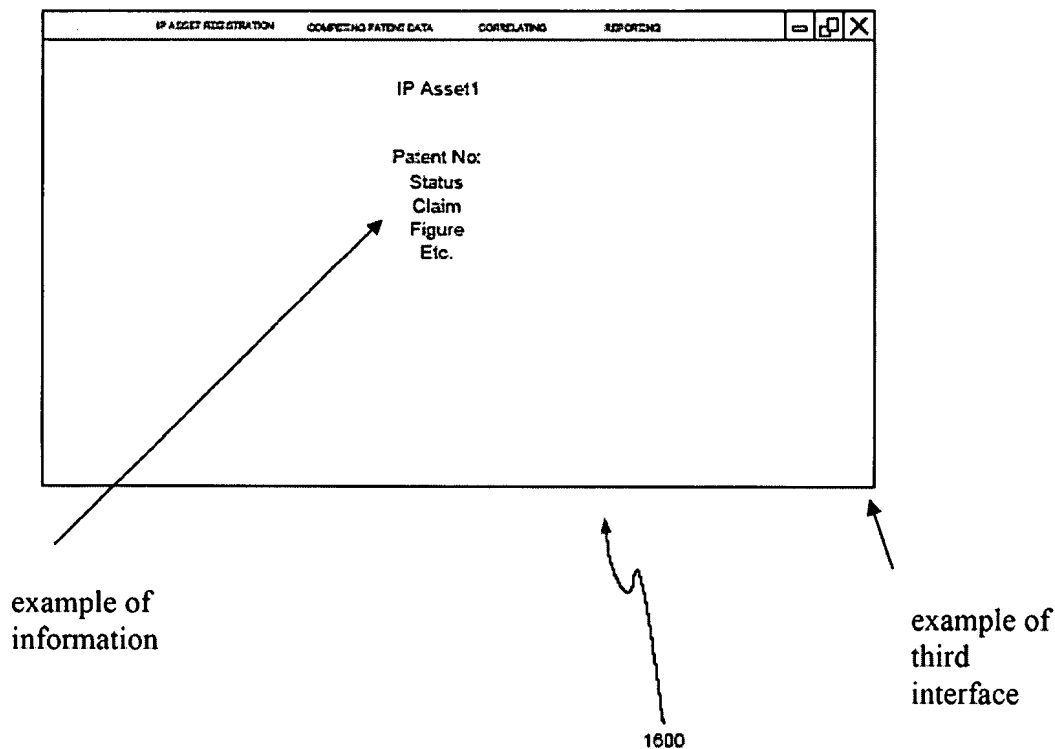


Figure 16

“In particular, upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented. Figure 16 illustrates an exemplary intellectual property details report 1600, in accordance with one embodiment. As shown, a patent number, status, exemplary claim and figure, etc. may be provided in such report. It should be noted that such intellectual property details report 1600 may also be generated directly utilizing the report definition interface 1200 by

selecting a particular intellectual property identifiers via pull-down window 1202, and selecting a details format type.” (emphasis added)

“As shown, the summary report 1500 lists each of the intellectual property identifiers, each competing patent, and each instance of competing activity associated with the appropriate technology category. For reasons that will soon become apparent, each item in the lists 1502 may include a link to an additional page with more information.”

In an alternate embodiment, an intellectual property identifier icon, competing patent icon, or a competing activity documentation icon may be selected separately.” (emphasis added)

“It should be noted that the electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by **drilling down** into selected areas.” (emphasis added)

Thus, in view of the experts provided above, applicant respectfully asserts that Claims 1-2, 4-13, 18-20 and 44-45 comply with the written description requirement under 35 U.S.C. 112, first paragraph.

In addition, the Examiner has rejected Claims 1-2, 4-13, 18-20 and 44-45 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has argued the following:

Applicant has a step of displaying a notes filed for receiving manually entered notes followed by a step of storing the entered notes. However, applicant never actually positively recites a step of actually receiving the notes.

The applicant has a step of *allowing the manual selection of a file*.

"Allowing" only requires making an action possible, not necessarily performing the action. Using terms like "allowing" or "permitting" an action, e.g. "allowing a user to select". Again, this is distinct from actually doing the action, e.g. selecting.

Such rejection is deemed avoided by virtue of the claim amendments above.

The Examiner has further argued:

The body of the claims have the following step:

storing the manually selected file in association with the at least one identifier by providing *a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier*.

First, it is not clear what applicant defines as a file. Second, what does the applicant mean by providing a correspondence between the file and the identifier. What is the applicant identifying as an identifier. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

This same step has the following language:

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus ***associating*** the manually selected file with the at least one identifier, thus associating the manually selected file with the at least one identifier, ***wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents***

What does the applicant mean by associating the file with the identifier?

In response, applicant relies on the plain and ordinary meaning of “file” and “identifier,” “correspondence,” “associated,” etc. Examples of such terms may be found in the figure below from the originally filed specification, and the related description.

1100

IP ASSET1	STATUS	IP ASSET1 INFORMATION	TECHNOLOGY GROUP	COMPETING PATENTS	COMPETING PATENTS INFORMATION	COMPETING ACTIVITY
IP ASSET1	PENDING	PAT #, TITLE, CLAIM, ETC.	TECHNOLOGY GROUP1	PAT #1	PAT #, TITLE, CLAIM, ETC.	URL1
				PAT #1	PAT #, TITLE, CLAIM, ETC.	FILE2
				PAT #3	PAT #, TITLE, CLAIM, ETC.	NOTES4 URL3
				PAT #3	PAT #, TITLE, CLAIM, ETC.	
IP ASSET2	ABANDONED	PAT #, TITLE, CLAIM, ETC.	TECHNOLOGY GROUP4	PAT #7		URL4
				PAT #5		FILE3
						NOTES1
IP ASSET3	ISSUED	PAT #, TITLE, CLAIM, ETC.	TECHNOLOGY GROUP3	PAT #1		URL6
				PAT #6		FILE12
				PAT #2		NOTES3
TECH GROUP1						URL1
TECH GROUP2						NOTES4

Figure 11

Applicant again emphasizes that the above citations should not be construed as limiting in any manner.

Further, the Examiner has argued:

The applicant has a step of storing the manually entered notes in association with at least one identifier and then a step of allowing a selection of a file. Then the applicant states that a manually selected first file is associated with a first identifier corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

First, is the first identifier the same identifier that the notes were stored with? Secondly, the applicant states that the notes are stored in association with at least one identifier, requiring only one identifier. If there is only one identifier, how can there be a first and second identifier. Are these in addition to the identifier stored with the notes? Furthermore, the applicant has a step of allowing the manual selection of a file. If there is only one file, how can there be a first file and a second file?

Regarding the first inquiry, the claim language is purposefully drafted in a broad manner so not to be limited to a scenario where “the first identifier is the same identifier that the notes were stored with.” In other words, it may or may not be and to specify one way or another would be unduly limiting to the claims.

Regarding the second inquiry, the claims do not require “only one identifier,” but rather “at least one.”

Also, the Examiner has argued the following:

The applicant has a step of *associating a plurality of patents with the at least one identifier*. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property. Thus, how can a plurality of patents be associated with one patent number?

Applicant respectfully asserts that the claims are not limited to “a plurality of patents [being] associated with one patent number,” as suggested by the Examiner. As noted by the Examiner, applicant’s specification as originally filed expressly states that the “identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with the intellectual property” (see Page 8, lines 11-14 - emphasis added).

Still yet, the Examiner has argued:

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant list the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier. The applicant then adds the language “wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. What does the applicant mean by accessible? It is not clear what applicant is claiming in this step.

In response, applicant relies on the plain and ordinary meaning of “accessible.”

Moreover, the Examiner has argued:

The applicant then has added the language that “wherein a set of patents is *reported* by – what does the applicant mean by “reported”? What set of patents are being reported?

In response, applicant relies on the plain and ordinary meaning of “reported.” Further, the claims have been clarified above.

The Examiner has additionally argued the following:

The applicant then states *displaying a technology mapping depicting one category of technology utilizing a graphical user interface and displaying statistics regarding a number of patents of the set in each category of technology.*

First, applicant only claims one category of technology in the displaying of a technology mapping. Then the applicant claims displaying statistics in each category of technology. How can one category become each category? Where does the technology mapping come from?

Regarding the present inquiry, the claims have been clarified to avoid this issue.

The Examiner has also argued:

Applicant then claims displaying first additional information associated with at least a portion of patents of the set in a second interface separate from the first interface upon the selection an positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, the first information including a list of patents of the set associated with one category of technology, displaying a second additional wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, an exemplary figure information; wherein the statistics are displayed in the first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface.

It is not clear how the set of patents being displayed is connected to the identifier or the file. It is unclear to the Examiner what the applicant is claiming in the claim language. **Applicant has started out with a notes field, storing the notes field with an identifier, selecting a file, storing the file, associating a plurality of patents with at least one identifier (it is not clear where the plurality of patents come from since there is no search being performed), making the notes and files and patents accessible by selection of the at least one identifier (however, where is it in the claim language that the notes, files and patents where ever correlated with one identifier). Applicant then states that a set of patents is reported (however, it is not clear what set of patents or if the set of patents relate to any of the steps above), displaying a technology mapping depicting at least one category of technology (note that the patents are not mentioned in this displaying step), displaying statistics**

regarding a number of patents of the set in each category (note that now we have more than one category, wherein the step above one requires one category), displaying additional information in a second interface, wherein the first additional information includes a list of the patents of the set associated with one category of technology (note that now we are back to one category of technology and that the information includes a list of the patents of the set associated with this one category of technology, however there is no earlier correlation with the technology mapping depicting at least one category of technology and a listing of patent), displaying second information associated with at least one of the patents in the list in a third interface (however, it is unclear where this list even comes from), wherein the second information is selected from the group consisting of a patent number, a status, a claim or a figure. What does this mean? Your first information is information associated with patents and your second information is a patent number, status????).

The claims have been clarified above to avoid these issues.

Further still, the Examiner has argued the following:

The applicant states in the claim language "that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail". This is unclear. What does the applicant mean by "made accessible?" Are they transmitted?

In Claims 5 and 6, it is unclear what the applicant means by the language "the at least one identifier is determined utilizing an add icon" or "a modify icon".

In Claims 8 and 9, it is unclear what the applicant means by the file is selected utilizing a file structure field? What is a file structure field? What does the applicant mean by the file structure field includes a file tree structure?

In Claim 12, it is unclear what the applicant means by the patents associated with the at least one identifier are identified by searching a database of already existing identifiers. This is unclear. It is not clear what the applicant is searching or what the applicant is searching for.

Applicant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and are not even technical in nature). In response, applicant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

The Examiner has also rejected Claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has argued that "applicant amended the invention from a method to a system but does not provide any structure to the system." Applicant has amended the claim to avoid such rejection.

The Examiner has rejected Claims 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 2003/0046307) in view

of Barnett et al. (U.S. Patent No. 2002/0082778). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to the independent claims.

The Examiner has relied on the Rivette and Barnett references to make a prior art showing of applicant's following claim language:

“displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology,

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure” (as amended-see this or similar, but not necessarily identical language in the independent claims).

First, the Examiner has argued that Figures 111-112 of Rivette meet applicant's claimed “displaying statistics...in a first interface, displaying first additional information in a second interface..., [and] displaying second additional information in a third interface” (see this or similar, but not necessarily identical language in the independent claims). Applicant respectfully disagrees and asserts that the description of Figures 111-

112 only states that “FIG. 111 is an example display format showing the display of patent text in a first window and notes in a second window” (see Paragraph [0101]), and that “FIG. 112 is an example display format showing the display of patent text in a first window and patent image in a second window” (see Paragraph [0102]).

Clearly, displaying patent text, patent notes, and a patent image, as in Rivette, fails to teach or suggest “displaying statistics...in a first interface” (emphasis added), as applicant claims. In fact, applicant notes that simply nowhere in Figures 111-112 of Rivette is there any showing of any sort of statistics, as applicant claims. Specifically, applicant points out that applicant claims “statistics regarding a number of the patents of the set in each category of technology,” in the context claimed. Figures 111-112 of Rivette only relate to patent text, patent notes, and a patent image associated with a single patent, such that Rivette does not disclose, and would not even suggest “displaying statistics regarding a number of the patents of the set in each category of technology” (emphasis added), as claimed. Similarly, Figures 111-112 of Rivette also does not show “displaying first additional information associated with at least a portion of the patents of the set in a second interface... wherein the first additional information includes a list of the patents of the set associated with one category of technology” (emphasis added), in the context claimed.

Moreover, applicant respectfully points out that on page 12 of the Office Action, the Examiner even admits that “Rivette does not explicitly [disclose]...wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface.” Thus, the Examiner has expressly acknowledged that Rivette does not disclose applicant’s claim language argued above.

Applicant further notes, however, that the Examiner relied on Figures 21-24 of Barnett in arguing that “Barnett discloses...[that] the first additional information includes a list of patents of the set associated with one category of technology, and where there is

second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, and wherein the statistics are displayed.”

Applicant respectfully asserts that the Examiner’s above cited argument fails to even address applicant’s claim language admitted by the Examiner to not be met by Rivette, namely “displaying statistics...in a first interface; displaying first additional information in a second interface separate from the first interface..., [and] displaying second additional information in a third interface separate from the first interface and the second interface,” as claimed. Thus, applicant respectfully asserts that the Examiner has failed to make any specific prior art showing of applicant’s specific claim language.

The Examiner has also relied on Paragraph [0270] in Rivette to meet applicant’s claimed “drilling down from the first interface to the second interface..., [and] drilling down from the second interface to the third interface” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that such excerpt from Rivette merely discloses that “[t]he operator may be able to uncover additional useful data by viewing, analyzing, and/or processing these parent and child groups, either with or without the original group.” In addition, applicant notes that Paragraph [0271] in Rivette simply mentions “data drilling.” Thus, it seems the Examiner has failed to consider the full weight of applicant’s claimed limitations.

In particular, as noted above, Rivette only generally teaches viewing, etc. parent and child groups with or without an original group, in addition to data drilling, which fails to specifically disclose “displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology, [and] displaying second additional information

associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface wherein the second additional information at least one of a patent number, a status, an exemplary claim, and an exemplary figure” (emphasis added), as claimed. Only applicant claims and teaches drilling down in such a specific manner.

Furthermore, the Examiner has argued that “Rivette displays interfaces showing different information relating to patents, wherein the interfaces have three interfaces (Figs 57, 125, 117)” to meet applicant’s claimed “displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface” (see this or similar, but not necessarily identical language in the independent claims-emphasis added).

Again, it seems that the Examiner has failed to consider the full weight of applicant’s claim language. Applicant respectfully asserts that simply disclosing interfaces showing different patent information, as noted by the Examiner, fails to specifically disclose “displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface” (emphasis added), in the context claimed by applicant. Applicant also respectfully asserts that Figures 57, 125, and 117 from Rivette, as relied on by the Examiner, also fail to disclose such specific claim language.

Still yet, the Examiner has admitted that Rivette does not explicitly disclose displaying a technology mapping, but has argued that “page 2 [0025] does not exclude technology mapping.” Applicant respectfully asserts that simply because the Rivette reference does not “exclude” something, does not mean it discloses, teaches, or suggests the same.

Moreover, applicant respectfully asserts that the Examiner has failed to make a specific prior art showing of all of applicant’s claim limitations. For example, the Examiner has failed to make a prior art showing of applicant’s claimed “displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology, [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure” (emphasis added), as claimed.

Applicant respectfully asserts that only applicant claims and teaches drilling down based on “selection of an icon positioned in the first interface and associated with one of the statistics,” and drilling down based on “selection of an additional icon positioned in the second interface and associated with one of the patents,” as claimed.

Applicant again emphasizes that many benefits arise from the synergy of the technology mapping, and the remaining claimed framework. Specifically, a user is capable of associating patents with at least one identifier (with additional notes associated therewith), and also obtaining technology-related metrics regarding a set of patents, with one framework that is more effectively organized (see details of claims). Specifically,

only applicant teaches and claims such a drill-down technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements.

Additionally, with respect to applicant's independent claims, the Examiner has argued that "these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited," in that the "data does not alter how the system functions or the steps are performed," and the "displaying would be performed the same regardless of the data." The Examiner has therefore concluded that "this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability."

Applicant respectfully disagrees and points out the following from MPEP 2106:

"The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among that data and the computing processes performed when utilizing that data. As such, a claim to that computer is statutory subject matter because it implements a statutory process."

Applicant respectfully emphasizes that applicant claims "displaying statistics... in a first interface" where "first additional information [is displayed]...in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface," as claimed. Clearly, such claim language requires a functional interrelationship, in that first additional information is displayed in a second interface separate from a first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics displayed in the first interface, as

claimed. Further, the selection of such icon results in a drilling down from the first interface to the second interface, as claimed.

Similarly, the abovementioned claim language requires a functional relationship with respect to the third interface, in that second additional information is displayed in a third interface from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, as claimed. Also, the selection of such additional icon result in a drilling down from the second interface to the third interface, as claimed.

The Examiner has further argued that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.”

In view of the above argument made by the Examiner, it seems the Examiner has simply dismissed the applicant’s claim limitations under Official Notice. In response, applicant again points out the remarks above that clearly show the manner in which some of such claims further distinguish the Rivette and Barnett references. Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

The Examiner has additionally argued that the “fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known.” Specifically, the Examiner has argued that “it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize e-mail as a way of communication.”

Applicant respectfully disagrees and points out that applicant specifically claims a technique “wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail,” as claimed. Applicant respectfully asserts that simply alleging that e-mail is well known, as noted by the Examiner, fails to consider the full weight of applicant’s claimed limitation, namely that “the notes and at least one of the files are made accessible to other parties utilizing e-mail” (emphasis added), as claimed.

Still yet, the Examiner has argued that “because of the way [the aforementioned claim language] is worded, it could encompass a person e-mailing another person to come look at the notes and files.” Applicant disagrees and respectfully asserts that applicant’s claims that “the notes and at least one of the files are made accessible... utilizing e-mail” (emphasis added), as claimed. Clearly, making notes and at least one file accessible utilizing e-mail, as claimed, does not simply “encompass a person e-mailing another person to come look at the notes and files,” as noted by the Examiner. In particular, in the situation where a person e-mails another person to come look at the notes and files, as suggested by the Examiner, requires the person to personally make the notes and files accessible to the other person.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art reference excerpts, as relied on by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claim 2, the Examiner has relied on Figure 147 and Paragraphs [0117]-[0120] and [0133]-[0134] in Rivette to make a prior art showing of applicant's claimed technique "wherein the at least one identifier is determined by selecting an already-existing identifier."

Applicant respectfully asserts that Figure 147 in Rivette merely relates to a list of patents in a repository, which clearly does not even suggest that "the at least one identifier is determined by selecting an already-existing identifier," particularly where "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed (see independent claim for context).

In addition, Paragraphs [0117]-[0120] and [0133]-[0134] in Rivette simply disclose an "example console screen shot," "an example screen shot for creating a group note," "example tools bars from the console screen display," "a stacked folder icon used to represent shared groups," and "an example console used to describe shared groups." Clearly, none of such excerpts specifically disclose the "the at least one identifier," as applicant claims, in which "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed. In view of the absence of applicant's claimed "at least one identifier" in such excerpts, such excerpts simply do not more specifically disclose that "the at least one identifier is determined by selecting an already-existing identifier," as claimed.

With respect to Claim 4, the Examiner has relied on Official Notice in rejecting applicant's claimed technique "wherein the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu." Specifically, the

Examiner has argued that it is obvious because, for example, “while doing a search in East, the Examiner may use a number from a pull down menu to select a search and then store this search as a new search.” In addition, the Examiner has argued that “it would have been obvious...to incorporate a pull-down menu...so as to allow for easy access to the identifiers.”

Applicant respectfully disagrees and asserts that, as noted above, Rivette fails to even suggest that “the at least one identifier is determined by selecting an already-existing identifier,” in the context claimed, such that it would not have been obvious for “the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu,” as suggested by the Examiner. In fact, applicant respectfully asserts that simply using a number from a pull down menu to select a search and then storing the search as a new search, as noted by the Examiner, does not even relate to applicant’s claimed “identifier” in which “manually entered notes [are associated] with the at least one identifier” and “a plurality of patents [are] associated with the at least one identifier,” in the context claimed (see independent claim for context).

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, applicant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Rivette. Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

With respect to Claims 5-6, the Examiner has relied on Official Notice in rejecting applicant’s claimed techniques “wherein the at least one identifier is determined utilizing an add icon” (Claim 5) and “wherein the at least one identifier is determined utilizing a modify icon” (Claim 6). Specifically, the Examiner has argued that “[i]t is old and well known to add a file and thus create a new file with a new identifier or modify the name of a file thus creating a new identifier.” In addition, the Examiner has argued

that “it would have been obvious...to incorporate...an add icon or a modify icon...so as to allow for easy access to the identifiers.”

Applicant respectfully disagrees and again asserts that, as noted above, Rivette fails to even suggest “the at least one identifier” in the context claimed by applicant, such that it would not have been obvious to determine such identifier utilizing an add icon (Claim 5) or a modify icon (Claim 6), in the context claimed.

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, applicant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Rivette. Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

With respect to Claim 7, the Examiner has relied on Figure 58 and item 13706 from Figure 137 in Rivette to make a prior art showing of applicant’s claimed technique “wherein the notes field allows a user to cut and paste notes.”

Applicant respectfully asserts that Figure 58 from Rivette merely shows the tool bar described with respect to Figure 137. However, applicant respectfully asserts that the description of item 13706 in Figure 137, as relied on by the Examiner, only discloses that “[a]n operator presses a Delete The Selected Group Or Patent Note button 13706 in order to delete the note selected in the Notes window 11708” (see Paragraph [1173]-emphasis added). Clearly, deleting a group or patent, as in Rivette, fails to meet applicant’s claimed “notes field [that] allows a user to cut and paste notes” (emphasis added), as claimed.

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a proper prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

To this end, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

Respectfully submitted,
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